

INTERFERENCE INITIAL MEMORANDUM

Count # 1

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 2 parties

PARTY <u>Vue et al.</u>	APPLICATION NO. <u>08/857,217</u>	FILING DATE <u>5-15-97</u>	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>Maintenance fees not due yet</u>				
**Accorded the benefit of:				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTED OR PATENTABLE CLAIMS PENDING <u>2,4,10,19</u>		UNPATENTABLE PENDING CLAIMS <u>None</u>		
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTED OR PATENTABLE CLAIMS PENDING <u>2,4,10,19 None</u>		UNPATENTABLE PENDING CLAIMS <u>NONE</u>		

PARTY <u>Leung et al.</u>	APPLICATION NO. <u>08/842,827</u>	FILING DATE <u>4-17-97</u>	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <u>Yes</u> <u>No</u> <u>Maintenance fees not due yet</u>				
**Accorded the benefit of:				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are):				
PATENTED OR PATENTABLE CLAIMS PENDING <u>1,4,14</u>		UNPATENTABLE PENDING CLAIMS <u>(3) - non-elected</u>		
The claim(s) of this party which does(do) not correspond to this count is(are):				
PATENTED OR PATENTABLE CLAIMS PENDING <u>7-9</u>		UNPATENTABLE PENDING CLAIMS <u>2,5,6,10-13,15,16 elected</u>		

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AND INTERFERENCES

Instructions

- For every patent involved in the interference, check if the maintenance fees have been paid by using the patent number with PALM screen 2970. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 USC 135(a); 37 CFR 1.606).
- For each party, identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 CFR 1.601(f), (n); 1.609(b)(2)).
- For each party, identify the patentable (or patented) and unpatentable (pending) claims which do not correspond to the count (37 CFR 1.609(b)(3)).
- Forward all files including those the benefit of which is being accorded.
- Keep a copy of the Interference Initial Memorandum and any attachments for your records.

All information requested below must be attached on (a) separate sheet(s) and type-written.

- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.
- For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 CFR 1.609(b)(2)).
- For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 CFR 1.609(b)(3)).
- For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE <u>7-10-98</u>	PRIMARY EXAMINER (Signature) <u>Rebecca Hunt</u>	TELEPHONE NO. <u>308-4000</u>	ART UNIT <u>1652</u>
DATE	GROUP DIRECTOR SIGNATURE (if required)		

**The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

Art Unit: 1652

Within the following count Sequence X is identical to SEQ ID NO:1 of 08/857,217 and SEQ ID NO:2 of 08/842,827 which are identical to each other.

Count:

A isolated and purified polynucleotide encoding a polypeptide comprising the amino acid sequence of Sequence X. This count is identical to Claim 2 of 08/857,217 and Claim 14 of 08/842,827 (Except for the substitution of Sequence X for the correct sequence ID number of each application).

Claims corresponding to the count:

Claim 1 corresponds to the count as it recites the genus of nucleic acids of the count.

Claim 3 corresponds to the count it recites a method of expressing the nucleic acids encoding human phosphatidic acid phosphatases which include the nucleic acids of the count. It would have been prima facie obvious to one of ordinary skill in the art to insert the nucleic acids of the count into any known expression vector, to transform this vector into any known host cell, and to culture the host cell and isolate the protein produced in order to obtain the encoded protein. However, this claim is not patentable because the scope of the nucleic acids encoding human phosphatidic acid phosphatases which may be used is not limited to the nucleic acids of the count (i.e., encoding

Art Unit: 1652

a specific human phosphatidic acid phosphatase) but include the use of prior art human phosphatidic acid phosphatase genes such as that of GENBANK entry U79294 as well. It would have been prima facie obvious to one of ordinary skill in the art to insert the nucleic acids of GENBANK entry U79294 into any known expression vector, to transform this vector into any known host cell, and to culture the host cell and isolate the protein produced in order to obtain the encoded protein.

Claim 4 corresponds to the count it recites a method of expressing the nucleic acids of the count. It would have been prima facie obvious to one of ordinary skill in the art to insert the nucleic acids of the count into any known expression vector, to transform this vector into any known host cell, and to culture the host cell and isolate the protein produced in order to obtain the encoded protein.

Claim 14 corresponds to the count as it recites the genus of nucleic acids of the count.

Claims not corresponding to the count:

Claims 2, and 5-13 do not correspond to the count as they recite proteins or methods of use thereof which are chemically distinct compounds from the nucleic acids of the count.

Claims 15 and 16 do not correspond to the count as they recite nucleic acids encoding human phosphatidic acid

Art Unit: 1652

phosphatases or methods of use thereof which are structurally distinct from the nucleic acids of the count as they encode human phosphatidic acid phosphatases with chemically different amino acid sequences. It should be noted that these claims have been designated as unpatentable herein solely because the subject matter of these claims has not been examined on the merits in either of the instant applications so no opinion on the patentability of these claims can be made at this time.

Art Unit: 1652

Within the following count Sequence X is identical to SEQ ID NO:1 of 08/857,217 and SEQ ID NO:2 of 08/842,827 which are identical to each other.

Count:

A isolated and purified polynucleotide encoding a polypeptide comprising the amino acid sequence of Sequence X. This count is identical to Claim 2 of 08/857,217 and Claim 14 of 08/842,827 (Except for the substitution of Sequence X for the correct sequence ID number of each application).

Claims corresponding to the count:

Claim 2 corresponds to the count as it recites the genus of nucleic acids of the count.

Claim 4 corresponds to the count as it recites a composition comprising the genus of nucleic acids of the count.

Claim 5 corresponds to the count as it recites a nucleic acid species within the genus of the patentable invention of the count.

Claims 6 and 7 correspond to the count as they recite a nucleic acids having a complementary sequence to the nucleic acids of the count and compositions thereof. A nucleic acid clearly suggests to the ordinary skilled artisan its complementary sequence because the known double helix structure of DNAs requires any DNA comprising a particular sequence to also

Art Unit: 1652

comprise its complementary sequence as well. As such a nucleic acid complementary to the nucleic acids of the count would have been prima facie obvious to one of ordinary skill in the art as such sequences are well known to be useful as probes for the complementary sequences (i.e., the nucleic acids of the count).

Claim 8 corresponds to the count it recites an expression vector including the nucleic acids of the count. It would have been prima facie obvious to one of ordinary skill in the art to insert the nucleic acids of the count into any known expression vector in order to produce the encoded protein.

Claim 9 corresponds to the count it recites a host cell transformed with the nucleic acids of the count. It would have been prima facie obvious to one of ordinary skill in the art to transform the nucleic acids of the count into any known host cell in order to produce the encoded protein.

Claim 10 corresponds to the count it recites a method of expressing the nucleic acids of the count. It would have been prima facie obvious to one of ordinary skill in the art to insert the nucleic acids of the count into any known expression vector, to transform this vector into any known host cell, and to culture the host cell and isolate the protein produced in order to obtain the encoded protein.

Claim 19 corresponds to the count it recites a method for detecting a polynucleotide encoding the protein of SEQ ID NO: 1

Serial Number: 08/857,217

Page 4

Art Unit: 1652

with the nucleic acids of Claim 6. It would have been prima facie obvious to one of ordinary skill in the art to use the nucleic acids of Claim 6 to probe a biological sample for the nucleic acids of the count as doing so would provide a means of identifying those cells expressing the encoded protein.